

REMARKS

Claims 1-42 are pending in the present application.

The Examiner has required election in the present application between:

Group I, claims 1-20, drawn to a method for managing a defective area on a record medium, classified in class 365, subclass 200; and

Group II, claims 21-42, drawn to a structure of a recording medium of writable write once type, classified in class 365, subclass 185.09.

For the purpose of examination of the present application, Applicants elect, with traverse, Group I, Claims 1-20, but the examination of all claims 1-42 or if not, at least claims 1-20 and 41-42 is requested for the following reasons.

Applicant respectfully traverses this requirement by submitting that the Office Action (1) fails to properly analyze the pending claims and (2) improperly applies the provisions of MPEP §806.05(h).

Claims 41 and 42 are apparatus claims that directly correspond to method claims 1 and 18. Thus, there is no undue burden on the Examiner to examine claims 1-20 and claims 41 and 42.

Furthermore, the Office Action fails to properly analyze the pending claims by incorrectly stating that claims 41 and 41, which recite an apparatus for managing a defective area on a recording medium of writable once type, are drawn to a structure of a recording medium of writable once type. Actually, claims 41 and 42 recite subject matter that falls into a separate statutory class of inventions, under 35 USC §101, than "a structure of a recording medium" with respect to which the Office Action categorizes

these claims. For this reason alone, the restriction requirement is improper and should be withdrawn.

The Office Action also fails to properly apply the provisions of MPEP §806.05(h) to the claimed invention. In this regard, Applicants respectfully note that the method, as claimed, recites managing a defective area on a recording medium of write once type, whereas the Office Action says the method can be used with any “other type of memory (i.e., DRAM, SRAM . . .). Applicant respectfully disagrees. DRAM is not a “recording medium of write-once type”, and SRAM does not use writing of any type. Moreover, even the broadest recording medium claims include (1) a defect management area, which the Office Action does not establish as existing in SRAM or DRAM; or (2) a replacement area, which the Office Action does not establish as existing in SRAM or DRAM.

Accordingly, the Office Action does not make out a *prima facie* case that the process for using the product as claimed can be practiced by another materially different method, e.g., DRAM or SRAM.

The Office Action also does not make out a *prima facie* case that the product as claimed can use a materially different process of using that claimed product. In this regard, the Office Action states that the memory, as claimed, can be tested with another method, e.g., redundancy. Applicant respectfully disagrees, because what is in issue is the method as claimed and the product as claimed, and the method as claimed is a method for “managing a defective area on a recording medium of writable once type.” Redundancy testing has not been explained nor has the Office Action demonstrated that redundancy testing will result in managing a defective area on a recording medium of writable once type.

Accordingly, Applicants respectfully submit that the restriction requirement fails to make out a prima facie case that Inventions I and II define independent and distinct inventions.

Furthermore, regardless of whether a restriction requirement is proper, the Office must examine all claims if there is no undue search burden on the examiner to examine all of the claims – see MPEP §803. In this regard, Applicant respectfully submits that the claimed invention is not properly classified in the class and subclasses indicated in the restriction requirement but, instead, is searchable and classifiable in class 369, entitled Dynamic Information Storage or Retrieval and that a reasonably comprehensive search of the prior art will involve searching the same subclasses for both the method of managing a defective area on the write once medium and the write once medium which is managed. Because the areas of search are coextensive, there should be no undue search burden on the Examiner to search and examine all pending claims. This rationale also applies to claims 41 and 42, which will have to be searched in all areas that the method of managing claims are searched and the recording medium is searched.

Furthermore, MPEP §812 clearly states that a restriction requirement can only be proper if it is made by an Examiner who would examine at least one of the inventions. Presumably, this invention will be handled by an Examiner different from the Examiner who has made this restriction requirement because this Application is not properly classifiable in the class and subclasses indicated in the restriction requirement. Accordingly, if the examiner who has made this restriction requirement does not handle the Application, then this restriction requirement must be withdrawn.

For the foregoing reasons, Applicants respectfully submit that this restriction requirement is improper and should be withdrawn.

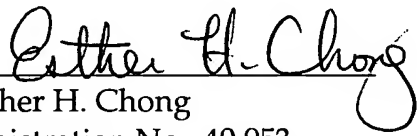
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

- ☐ Attached is a Petition for Extension of Time.
- ☐ Attached hereto is the fee transmittal listing the required fees.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: May 20, 2005

Respectfully submitted,

By 
Esther H. Chong
Registration No.: 40,953
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Rd
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant